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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,129	01/20/2000	Patrick W. Mullen	1571.1144001	3992
21005	7590	01/19/2005	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/488,129

Applicant(s)

MULLEN ET AL.

Examiner

Alicia Chevalier

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-6, 11-15, 18, 22-27, 29-31 and 49.Claim(s) objected to: 33 and 45.Claim(s) rejected: 32, 44 and 46-48.Claim(s) withdrawn from consideration: 34-43.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

1-18-05
AC

Continuation Sheet

Continuation of 5. because: It remains the Examiner's position that the claims are unpatentable for reasons previously of record in the final office action.

Response to Applicant's Arguments

1. Applicant's arguments in the after final response filed January 5, 2005 regarding the 35 U.S.C. §103 rejection of claims 32, 44 and 46-48 as over Benson et al. (US Patent No. 6,287,670) in view of Martin et al. (U.S. Patent No. 5,786,066) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Martin does not teach chips with each chip length less than about 457 micrometers. Then Applicant points out that although the height of the prisms is about 449 micrometers, the length along the window side of each prism is about 898 micrometers.

The Examiner does not understand how or where Applicant found the height of the prisms to be 449 micrometers and the lengths along the "window" side to be 898 micrometers. The only height the Examiner is able to find in the reference is in column 2, lines 49-50, where it recites microprisms 14, about 2.8 mils high, which is equivalent to 71 micrometers in height. Furthermore, Applicant merely repeats what the examiner pointed out reference that Martin discloses at column 3, lines 36-37 that individual retroreflective prism have side dimensions of less than about 0.025 inches (635 micrometers), but does not explain why this section does not teach Applicant's claimed limitation chip length less than about 457 micrometers. Applicant's arguments fail to specifically point out how the reference fails to meet the claimed limitation.

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Applicant further argues that the Examiner is improperly combining the teachings of Benson and Martin because Benson discloses an open-faced sheeting while Martin discloses a traditional cub-corner prism.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Martin discloses that retroreflective sheet/array can be cut into thousands of very small individual retroreflective prisms and mixed with paint or transparent binder and applied as a decorative retroreflective coating (*Martin col. 3, lines 36-44*). Irregardless of whether the retroreflective prisms are open-faced or traditional, Martin still discloses that individual retroreflective prisms are useful in paint or binders to create decorative retroreflective coatings. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make Benson's retroreflective sheeting into individual retroreflective chips with a length of less than about 457 micrometers as taught by Martin in order allow the retroreflective sheeting to be mixed with a matrix. One of ordinary skill in the art would have been motivated to make Benson's retroreflective sheeting into small chips because it would allow the chips to be mixed with paint or a transparent binder and applied as a decorative retroreflective coating to a suitable substrate, such as, fabrics, wood, plastic or metal panels, or the like (*col. 3, lines 37-40*).

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Conclusion


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

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HAROLD PYON
SUPERVISORY PATENT EXAMINER
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